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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,456	07/29/2003	Wilhelmus Hermanus Hendrikus Maria Kieftenbeld	2001-1150-1	4835

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EXAMINER

HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,456

Applicant(s)KIEFTENBELD, WILHELMUS
HERMANUS HENDRIK**Examiner**

Susan Hanley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/968,043.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The use of the trademark UltraClear® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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Claim Objections

Claims 2 and 4 are objected to because of the following informalities: The quotation marks around the term backbone are superfluous. It is suggested that they be deleted. the word "apolair" in claim 4 appears to be misspelled.

Claims 5 and 7 are rejected because the hyphens before the solvents are unnecessary. It is suggested that they be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected because the term "in particular" creates a range within a range for the claimed aprotic solvent. It is unclear if the particular mixture of apolair [sic] aprotic solvents is part of the claim.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "the organic solvent is an aprotic solvent", and the claim also recites "a mixture of apolair [sic] aprotic solvent" which is the narrower statement of the range/limitation.

Regarding claims 5 and 8, the phrases "such as" and "e.g." render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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The term "similar" in claim 6 is a relative term which renders the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 6 is rejected because the trademark UltraClear® is vague and indefinite. A trademark name does not guarantee that the substance having the trademark name will have the same composition or even be available over time. Since the composition for UltraClear® may not be constant, the practitioner could not practice the invention commensurate with the claims. Hence, the use of a trademark in a claim renders the claim vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 6 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hyde (US 4,341,673).

Hyde discloses a composition comprising a methacrylate polymer, a paraffinic oil and an alkyl methacrylate, having 2-4 C in the ester moiety, as in claims 1-2 and 4 (abstract). The composition is 5-12% by weight of liquid mixture of a paraffinic oil, as in claim 7 (claims). The paraffin is a mixture of hydrocarbons, as in claim 6. Although Hyde discloses that the disclosed composition can be used as a polymer concrete mix, the composition still meets the claim limitations because it has the required components and does not contain a substance that would make it unsuitable as a mounting medium.

Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Govek et al. (US 6,589,650).

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Govek et al. disclose a coverslip material comprising a light-transmissible polymeric backing having two sides. One side is a non-tacky bonding layer comprising polymers such as esters of polyacrylates and polymethacrylates and combinations thereof, as in claims 1 and 2 (col. 4, lines 30-56). The opposite side is coated with a protective material. Prior to placing the coverslip on the specimen, the practitioner contacts the bonding layers with a solvent such as an aliphatic hydrocarbon blend, as in claims 1, 4 and 6, or petroleum distillate, a diterpene or a coconut oil ester (col. 2, lines 52-60). Paraffin is made from petroleum distillates. When the solvent contacts the polymer bonding layer, it at least partially dissolves the polymer to make a tacky surface to which the specimen can adhere (col. 4, lines 10-20). Thus, the procedure of contacting the bonding layers with a saturated hydrocarbon solvent creates an area on the bonding layer where the polymer is solvated in the solvent. This is the definition of a solution. Thus, the disclosure by Govek et al. meets the limitations of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Govek et al. (US 6,589,650) in view of Groat (1950).

The disclosure of Govek et al. is discussed *vide supra*.

Govek et al. do not disclose the use of a polymer comprising an monomer of isobutyl methacrylate as a bonding layer

Groat discloses the preparation of mounting media for microscopy comprising low molecular weight resins of copolymers of isobutyl methacrylate and styrene dissolved in a nonpolar solvent such as toluene. Isobutyl methacrylate is suitable for a mounting medium because it has suitable fluidity in a hydrocarbon solvent, adheres to glass and has excellent light transmission.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a resin comprising isobutyl methacrylate as a bonding layer for the cover slip taught by Govek et al. The ordinary artisan would have been motivated to do so because isobutyl methacrylate resins are well known for fixing microscopy specimens. The ordinary artisan would have known at the time the invention was made that isobutyl methacrylate has suitable properties for microscopy and that it had been successfully employed as a copolymer for mounting media.

Claim 8 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Govek et al (US 6,589,650).

The disclosure of Govek et al. is discussed *vide supra*.

Govek et al. do not disclose the viscosity of the of the solution formed when the acrylic ester resin of the bonding material is dissolved in the saturated hydrocarbon.

It is noted that the PTO is not equipped with a laboratory to compare the properties of a claimed substance with that disclosed by the prior art. However, the solution formed by the contact of the acrylic ester resin of the bonding material is dissolved in the saturated hydrocarbon taught by Govek et al. would inherently have the claimed viscosity. The materials disclosed by Govek et al. possess the same physical properties as those claimed in instant claim 8. Hence, the mixture of those substances will make a solution having the same viscosity properties.

In the alternative, if the claimed viscosity values are not inherent in the solution disclosed by Govek et al., it would have been obvious to expect that the claimed and disclosed viscosities were the same. The ordinary artisan would have had a reasonable expectation that the viscosity properties would be the same because the materials disclosed by Govek et al. possess the same physical properties as those claimed in instant invention.

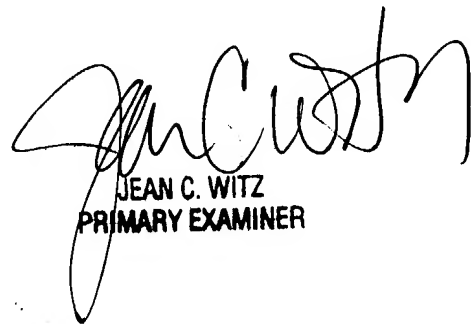
It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Hanley whose telephone number is 571-272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEAN C. WITZ
PRIMARY EXAMINER